

REMARKS

Claims 1 to 4, 7 to 10, 13 to 16 and 19 to 24 are now pending and being considered in this application (since claims 5, 6, 11, 12, 17 and 18 were previously withdrawn in response to a restriction requirement).

It is respectfully submitted that all of the presently pending and considered claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for acknowledging acceptance of the Drawings, and for acknowledging that certified copies of the of the priority documents have been received.

Claims 7 to 10 and 13 to 16 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

While the rejections may not be agreed with, to facilitate matters, claims 7 to 10 and 13 to 16 have been rewritten, where appropriate. It is therefore respectfully requested that the Section 101 rejections be withdrawn as moot.

Claims 1, 3, 7, 9, 13, 15, 19, 21 and 23 were rejected under 35 U.S.C. § 102(e) as anticipated by Cox al., U.S. Patent No. 5,915,027.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully

submitted that any anticipation rejection premised on the inherency doctrine must fail absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, each of the independent claims has been rewritten to better clarify the claimed subject matter.

As to claim 1 (and other corresponding independent claims), the Office Action cited col. 8, lines 40-54, in Cox for both of the claim features of “obtaining a frequency coefficient of said block data” and “obtaining a complexity of said block data”. In fact, that portion in Cox only refers to dividing an image into 8 x 8 blocks, obtaining DCT coefficients, inserting a PN sequence into the DCT coefficients, and cyclically rotating the PN sequence by one frequency coefficient prior to insertion. Even if Cox may somehow indicate obtaining a frequency coefficient of block data by performing orthogonal transform (DCT), Cox does not disclose nor suggest the feature of “obtaining a complexity of said block data” by performing a transform different from DCT, as provided for in the context of the claimed subject matter.

In column 4, lines 50-53, Cox refers to wavelet type decomposition, but, as is clear from the referenced text, the wavelet type decomposition is an alternative method for DCT for obtaining frequency components. Accordingly, Cox does not disclose nor suggest the claim feature of “obtaining a complexity of said block data by performing a wavelet transform” separately from the feature “obtaining a frequency coefficient of said block data by performing an orthogonal transform”, as provided for in the context of the presently claimed subject matter.

As to claim 3 (and other corresponding independent claims), the Office Action conclusorily asserted that the text at col. 8, lines 40-54, in Cox somehow discloses the claim feature of “obtaining a frequency coefficient of said block data”, and conclusorily asserted that the text at column 5, lines 47-58, and column 6, lines 3-49, somehow discloses the claim feature of “obtaining an amount of transformation”. In fact, the portion of column 5, lines 47-58, refers to extracting watermark using correlators and an error corrector, and the portion of column 6, lines 3-49, merely refers to watermark insertion and extraction procedures, so that these cited portions plainly do not disclose nor suggest the claim features as provided for in the context of the claimed subject matter.

Still further, claim 3 includes the added feature of “said quantization width being obtained . . . based on difference values of frequency coefficients, obtained by using orthogonal transform, between block data of original image data and block data that is

obtained by manipulating said block data of said original image data with said manipulation” – which is plainly not disclosed nor suggested in any way by the Cox reference.

As to the secondary Ho reference, it is cited as to dependent claim 4. But, Ho merely refers to zigzag scanning and statistical analysis for transform coefficients using a threshold value (column 7, line 45 to column 8, line 49), and therefore does not disclose nor in any way suggest the claim feature “said quantization width being obtained . . . based on difference values of frequency coefficients, obtained by using orthogonal transform, between block data of original image data and block data that is obtained by manipulating said block data of said original image data with said manipulation method”, as provided for in the context of the presently claimed subject matter.

Accordingly, claims 1 and 3, as presented, are allowable, as are their respective dependent claims 2 and 4.

Claims 7, 13 and 19, as presented, also now include features like those of claim 1, as presented, and are therefore allowable for essentially the same reasons as claim 1, as are their respective dependent claims 8, 14 and 20.

Claims 9, 15, 21 and 23, as presented, also now include features like those of claim 3, as presented, and are therefore allowable for essentially the same reasons as claim 3, as are their respective dependent claims 10, 16, 22, and 24.

Claims 2, 4, 8, 10, 14, 16, 20, 22 and 24 were rejected under 35 U.S.C. § 103(a) as obvious over Cox et al. in view of Ho et al., U.S. patent No. 6,983,057, and in view of the Background Information (which the Office characterizes as “Applicants Own Admitted Art”).

Regardless of the proper characterization of the Background Information, the following is respectfully submitted:

As explained above, claims 1 and 3 are allowable, as are their respective dependent claims 2 and 4, since the foregoing features are nowhere disclosed nor suggested by the Cox reference.

Also, claims 7, 13 and 19, as presented, also now include features like those of claim 1, as presented, and are therefore allowable for essentially the same reasons as claim 1, as

presented, as are their respective dependent claims 8, 14 and 20.

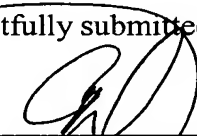
Also, claims 9, 15, 21 and 23, as presented, also now include features like those of claim 3, as presented, and are therefore allowable for essentially the same reasons as claim 3, as presented, as are their respective dependent claims 10, 16, 22, and 24.

In short, claims 2, 4, 8, 10, 14, 16, 20, 22 and 24 respectively depend from their respective base claims, as presented, and are therefore allowable for essentially the same reasons as their respective base claims, as explained above, since the secondary reference and the Background Information does not cure – and is not asserted to cure – the critical deficiencies of the primary Cox reference.

Accordingly, pending and considered claims 1 to 4, 7 to 10, 13 to 16 and 19 to 24 are allowable.

Conclusion

It is therefore respectfully submitted that pending and considered claims 1 to 4, 7 to 10, 13 to 16 and 19 to 24 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,
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